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EXAMINER

SOLAIMAN, SHIREEN I

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 02/27/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/781,605	WRIGHT ET AL.
	Examiner	Art Unit
	Shireen I Solaiman	2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

DOV POPOVICI
DOV POPOVICI

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 647 *2/13/03*
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Teshima (U.S. Patent # 6,272,470).

As to Claim 12, Teshima discloses a system for maintaining personal data, the system comprising:

entering means for entering personal data (see Fig. 6, 120, write consultation records in a patient card); storing means for storing the personal data (see fig. 6, 1116 record name of consulting physician); accessing means for accessing the stored personal data (see fig. 6, 116 can select a consultation report from a list) wherein the accessing means comprises a PC with an optical disk drive (see Fig. 1, 11) and an Internet web browser (see column 9, lines 40-53); transferring means for transferring the stored personal data between the entering means and the storing means in a secure mode (see column 8, lines 1-15, operators id is recorded and data

Art Unit: 2175

encrypting/decrypting makes network safe); and updating means for updating the stored personal data (see column 5, lines 26-34, the updated consultation record is then written in the patient card and stored therein)wherein the updating means comprises using the Internet web browser (see column 9, lines 40-53).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) in view of Zubeldia et al. (U.S. Patent # 6,397,224).

As to Claim 1, Teshima discloses a personal information system, comprising:
a subscriber computer with an optical disk drive (see column 10, lines 17-21,in case of the optical card, data is input or output by way of a dedicated device driver); a portable optical disk readable by the optical disk drive (see column 10, lines 17-21, optical card, which reads on portable optical disk); a database management server comprising a database (see column 2, lines 15-20, medical information database) and an optical disk writer (see Fig 2, 13 optical input / output unit) wherein the optical disk writer writes the personal data to the portable optical disk (see column 1, lines 17-21, name address blood type etc are stored in the patient card) the

personal data being viewable and downloadable by the subscriber computer (see Fig. 2, 13, patient card input/output apparatus facilitates the interaction with data); and a subscriber interface comprising an Internet web browser wherein the Internet browser is used to view personal data on the portable optical disk (see column 9, lines 40-53) and to update data stored on the database management server (see column 12, lines 40-53, as the clinical records can be stored externally).

Teshima does not teach database management server comprising a database including personal data.

Zubeldia et al. teaches a database management server comprising a database including personal data (see fig 1 and 2, subscriber computer reads on 18, and database server 84, as it creates encoded identity reference from the input to the output data).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima to include a database management server comprising a database including personal data.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Zubeldia et al to include a database management server comprising a database including personal data because it allows identifying an individual to whom the patient record pertains to (Zubeldia et al. column 5, lines 26-34).

Art Unit: 2175

As to Claim 2, Teshima as modified discloses wherein the personal data to be stored on the portable optical disk is selectable using the subscriber interface (see fig. 6, 113 can select a consultation report from a list).

As to Claim 3, Teshima as modified does not teach wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

Zubeldia et al. teaches wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode (see fig 1 and 2, subscriber computer reads on 18, and database server 84, as it creates encoded identity reference from the input to the output data).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia et al wherein the personal data is transferred between the subscriber computer and the database management server in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information that is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 4, Teshima as modified discloses wherein the transfer of personal data between the subscriber computer and the database management server can be initiated by either the subscriber computer or the database management server (see column 16, lines 37-67 and column 17, lines 1-33, image data can be initiated by the physician for consultation and the image data can also be film digitalized and downloaded to the server where image data reads on personal data) the data transfer occurring either in a real-time mode or a batch mode (see column 5, lines 26-34, the consultation records are stored into the patient card at any time or as a batch job).

As to Claim 5, Teshima as modified discloses wherein the personal data comprises text, image, audio, and video data (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled).

As to Claim 6, Teshima discloses method of maintaining personal data on a portable optical disk (see column 10, lines 17-21), the method comprising: writing the personal data onto the portable optical disk wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser interface; and delivering the portable optical disk to a subscriber (delivering the disk can be accomplished by handing the card to a patient or by mail which is well known).

Zubeldia et al. teaches entering personal data onto a database management server wherein the personal data is stored in the database management server (see fig 2, database server

Art Unit: 2175

54, as identifying element of the input data must be entered in the database and column 5, lines 26-34, a name, a birth date, an address, a ZIP code, a telephone number, a healthcare identifier).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima to include entering personal data onto a database management server wherein the personal data is stored in the database management server.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Zubeldia et al to include entering personal data onto a database management server wherein the personal data is stored in the database management server because it allows to identify an individual to whom the patient record pertains to (Zubeldia et al. column 5, lines 26-34).

As to Claim 7, Teshima as modified discloses wherein the personal data residing on the database management server can be updated using the Internet web browser interface (see Fig. 1, if an Xray is taken at Hospital B then only way to store the digitalized film is to go through the internet and see column 16, lines 37-67 and column 17, lines 1-33, the image data can also be film digitalized and downloaded to the server where image data reads on personal data).

As to Claim 8, Teshima as modified discloses wherein the personal data to be updated is selectable by the subscriber (see fig. 6, 113 can select consultation report from a list to be updated).

As to Claim 9, Teshima as modified does not teach wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

Zubeldia et al. teaches wherein entering, writing, and updating the personal data are in an HIPAA compliant mode (see column 7, lines 17-49, new records are assigned a new code and update records reuse the same code).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima as modified wherein entering, writing, and updating the personal data are in an HIPAA compliant mode.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima as modified with the teachings of Zubeldia et al wherein entering, writing, and updating the personal data are in an HIPAA compliant mode because the HIPAA establishes severe penalties for "wrongful disclosure" of health information that is individually identifiable. (Zubeldia et al. column 1, lines 57-60).

As to Claim 10, Teshima as modified discloses using the portable optical disk at any healthcare service center to prevent repetitious registration process at different healthcare service center sites (see Fig. 1, same patient card can be used at Hospital A and B without further registration).

As to Claim 11, Teshima as modified discloses wherein the portable optical disk is created at the health care service center site (see column 3, lines 27-52, an individual keeps a portable storage medium functioned as a clinical recording as a health care/medical care card

when consulting at a medical institution implies the card must be created at or with the consent of the health care service center as the card must conform to HTML or SGML formats).

5. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima (U.S. Patent # 6,272,470) in view of Feinberg (U.S. Patent # 6,415,295).

As to Claim 13, Teshima discloses a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising personal data, wherein the personal data comprises demographics (see column 1, lines 17-21, name address), medical data (see column 1, lines 6-8) and conditions of admission (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser interface (see column 9, lines 40-53).

Teshima does not teach wherein the personal data comprises living will and power of attorney.

Feinberg teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinberg wherein the personal data comprises living will and power of attorney because it allows access to medical information in case of emergency (Feinberg column 1, lines 57-60).

As to Claim 14, Teshima discloses a personal data management system comprising: a portable optical disk (see column 10, lines 17-21, optical card, which reads on portable optical disk) comprising demographics (see column 1, lines 17-21, address), medical data (see column 1, lines 6-8), living will, power of attorney, and conditions of admissions (see column 3, lines 16-26, consultation record) in formats including text, images, audio, and video (see column 9, lines 40-50, in consulting records still image, motion picture, voice, chart, and list can therefore be handled) wherein the portable optical disk is readable from an optical disk drive (see column 10, lines 17-21) using an Internet web browser (see column 9, lines 40-53); and a database management server comprising an optical disk writer and a database wherein the database contains the personal data to be written to the portable optical disk using the optical disk writer (see Fig 1, image database, contains images to be recorded on the card).

Teshima does not teach wherein the personal data comprises living will and power of attorney.

Feinberg teaches wherein the personal data comprises living will and power of attorney (see column 5, lines 39-53, living will reads on donor, power of attorney reads on directives).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Teshima wherein the personal data comprises living will and power of attorney.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Teshima with the teachings of Feinberg wherein the personal data comprises living will and power of attorney because it allows access to medical information in case of emergency (Feinberg column 1, lines 57-60).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shireen I Solaiman whose telephone number is 703-305-5893. The examiner can normally be reached on 8-4:30 M-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

SIS
February 13, 2003

Dov Popovici
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SUPERVISORY PATENT EXAMINER
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